

REMARKS

I. Introduction

Applicant thanks Examiner Anderson for the applicant's amendment examination, as detailed in the Office action (Paper 4) mailed 10 April 2003. With claims 1, 3-8, 10, 11, 13, and 14 remaining under prosecution in this application, applicant respectfully requests reconsideration of the application in view of the following arguments.

II. Claim rejection under 35 U.S.C. § 102

Claims 1, 5, as amended, were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Farrell et al. "Farrel is cited," the Office action asserts, 'showing a double-sided rack system having tracks 22 supporting storage units 32 with shelves 16 and partitions 18 to form cells and a drive mechanism, see col. 5, lines 48-50. Farrel discloses that commercial mobile storage systems are typically made from metal. It is inherent that a metal shelving system would be grounded. The recitation of a newly discovered function or property inherently possessed by things in the prior art does not cause a claim drawn to these things to distinguish over the prior art.' "The PTO," the Office action continues, 'may require the applicant to prove that the prior art does not possess the characteristics relied on. *In re Swinehart and Sfiligoj* 169 USPQ 226 (1971).'

Applicant respectfully disagrees.

Claim 1, as amended, claims a reticle storing movable rack system, in which, inter alia, racks are electrically grounded and cells on shelves of the racks are made metallic and electrically connected to the racks. These limitations are structural, and

they are neither disclosed nor taught in the Farrell et al. patent 5,160,190 (further referred to as “the ‘190 patent”). The system disclosed in the ‘190 patent is intended to store “various things such as files or books” (the ‘190 patent, col. 5, line 38). And it is only deflector 56 (FIG. 5 of the ‘190 patent) and shelving 16 that are shown made of metal in the structure of the ‘190 patent. In other words, the ‘190 patent lacks an electrical connection between what it is intended to hold (files or books) and the ground through shelving and racks (ranges 14 in the ‘190 patent). As to the assertion in the Office action that “[i]t is inherent that a metal shelving system would be grounded,” applicant would like to refer to case law, according to which “when an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory.” *Ex parte Schricker*, 56 USPQ 2d 1723, 1725 (B.P.A.I. 2000)(unpublished). The ‘190 patent does not seem to suggest the presence of the above-mentioned structural limitation of the applicant’s invention in the form of the electrical connection.

What the Office action asserts with regard to “newly discovered function or property inherently possessed by things in the prior art” (emphasis added – R.T.) is believed to be irrelevant with respect to the above-discussed structural limitations present in the applicant’s invention and absent in the prior art. The case cited in the Office action also dealt with functional, rather than structural, limitations and, accordingly, with functional language (*In re Swinehart and Sfiligoj* 169 USPQ 228, and especially 229 (1971)).

With the above in view, applicant believes that novelty of claim 1, as amended, remains unshaken by the Farrell et al. patent and respectfully submits that claim 1 be

allowed. Claims 3-5 are believed to be patentable as dependent from patentable base claim 1.

III. Claim rejection under 35 U.S.C. § 103

Claims 3, 4, 6-8, 10, 11, 13, and 14 were rejected under 35 U.S.C. § 103 as being unpatentable over Farrell et al as applied to claims 1 and 5, and further in view of Spitzer et al. The Office action asserts that whereas Farrell fails to show sloped shelves, Spitzer is cited disclosing a mobile rack shelves 125 sloped to prevent cargo spillage. The angle of the shelves, the Office action continues, is considered an obvious matter of design choice for one having an ordinary skill in the art. "Since the references are from the same field of endeavor," concludes the Office action, "the purpose of Spitzer would have been obvious in the pertinent art of Farrell at the time of the invention it would have been obvious for one having an ordinary skill in the art to have modified Farrell with shelves sloped to prevent cargo spillage in view of Spitzer."

Applicant respectfully disagrees.

Claims 3 and 4 are believed to be patentable as dependent from patentable base claim 1.

Claim 6 comprises, inter alia, limitations of (1) shelves with plurality of cells for housing reticles therein, and (2) the cells having electrostatic shielding properties. Farrell has neither of those limitations, and adding Spitzer does not affect those arguments since Spitzer also does not disclose or teach either first or second of the above-identified limitation. Neither Farrell nor Spitzer addresses the problem of imparting electrostatic shielding properties to the "things" held on the shelves. Accordingly, prior art references

do not suggest any modification associated with the problem that is solved in the applicant's invention.

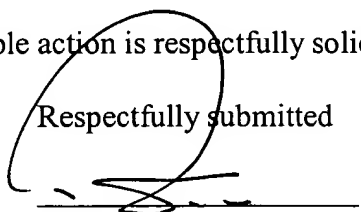
In addition to the limitations (1) and (2) that differ the applicant's invention from what was disclosed in both Farrell and Spitzer, claim 11 comprises limitation (3) of the cells made metallic and electrically connected to electrically grounded racks. This limitation is disclosed neither in Farrell nor in Spitzer. For that reason, all the above arguments in favor of patentability of claim 6 are fully applicable to claim 11.

With this in view, applicant believes that the 35 U.S.C. § 103 rejection of claims 6 and 11 is thus overcome and respectfully submits that it be withdrawn. Claims 7, 8, 10, 13, and 14 are believed to be patentable as dependent from patentable base claims 6 and 11.

IV. Conclusion

All the above considered, applicant believes that claims 1, 3-8, 10, 11, 13, and 14 are in the condition of allowance, and this favorable action is respectfully solicited.

Respectfully submitted



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